

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the present amendment and in light of the following discussion is respectfully requested.

Claims 1-9 and 21-31 are pending. In the present amendment, Claims 1, 21, and 22 are currently amended and new Claims 28-31 are added. Support for the present amendment can be found in the original specification, for example, at page 8, line 26 to page 9, line 27 and in Figure 4. Thus, it is respectfully submitted that no new matter is added.

In the outstanding Office Action, Claims 1-5, 7-10, and 21-27 were rejected under 35 U.S.C. § 102(a,e) as anticipated by Schneider et al. (U.S. Patent No. 6,364,957, hereinafter “Schneider”); and Claim 6 was rejected under 35 U.S.C. § 103(a) as unpatentable over Schneider in view of Wicker et al. (U.S. Patent No. 6,464,843, hereinafter “Wicker”).

Turning now to the rejections under 35 U.S.C. § 102(a,e) and 35 U.S.C. § 103(a), Applicants respectfully request reconsideration of these rejections and traverse these rejections, as discussed below.

Claim 1 is hereby amended to clarify that the step receiving surface, on which the secondary focus ring is positioned, is part of the focus ring, not the substrate holder. An exemplary embodiment of such a step receiving surface is shown in Figure 4 as reference numeral 264. The Office Action, in section 2 on page 2, equates the outer ring 290 and shoulder 215 of the substrate holder 38 shown in Figure 11 of Schneider to the claimed “focus ring including a step receiving surface.”

However, as can be seen in Figure 11 of Schneider, the shoulder 215 is part of the substrate holder 38, **not** the outer ring 290. Further, the inner ring 282 is not positioned on the outer ring 290.

The Office Action also takes the position, in section 2 on pages 2 and 3, that claim language defining the positioning of the focus ring and secondary focus ring with respect to

the substrate and substrate holder is intended use, and thus does not give this claim language any patentable weight. Applicants respectfully request that this position be reconsidered.

Claim 1 recites a focus ring including “an outer radial lip surface positioned radially outward from a peripheral edge of the substrate.” Claim 1 also recites a secondary focus ring including “an inner radial edge surface positioned radially outward from the peripheral edge of the substrate.” The Office Action states that these are “intended use requirements in the pending apparatus claims dependent on the size (diameter) of the substrate 15 used.”

Applicants respectfully disagree because these claims define the positioning of the focus ring and secondary focus ring *regardless of the size of the substrate*. Accordingly, whether the substrate has a large or small diameter, the claims define the same positioning of the focus ring and secondary focus ring that must be met to be covered by the claims.

The Office Action further cites *In re Walter* and MPEP 2106 for the proposition that “claim language that simply specifies an intended use or field of use for the invention generally will not limit the scope of a claim.” Regarding *In re Walter*, the issue before the court was whether a use recited *in a preamble* prevented an otherwise non-statutory algorithm from being rejected *under 35 U.S.C. § 101*. Thus, *In re Walter* is not analogous to the present situation and does not govern how the claim language quoted above should be interpreted under 35 U.S.C. §§ 102 and 103.

Further, MPEP 2106, in section VI. discusses determining whether the claimed invention complies with 35 U.S.C. §§ 102 and 103. This section states that “[r]eviewing a claimed invention for compliance with 35 U.S.C. 102 and 103 begins with a comparison of the claimed subject matter to what is known in the prior art” and that MPEP 2131-2146 provides “specific guidance on patentability determinations under 35 U.S.C. § 102 and 103.” Thus, MPEP 2106 does not make any exception for the claimed subject matter recited above when being compared with what is known in the prior art.

Accordingly, Applicants respectfully submit that the claim language in question is not merely a recitation of intended use, and should be given patentable weight as it is well established that each word of every claim must be given weight. See *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As discussed in the previous response, the cited references do not disclose or suggest every feature recited in amended Claim 1.

Schneider describes a support assembly 30 for supporting a substrate 15 including a collar 130 that comprises a first ring and a second ring.¹ Figures 6, 8, and 11 each show an embodiment of collar 130 including first and second rings.

However, it is respectfully submitted that Schneider does not disclose or suggest “a secondary focus ring positioned on the step receiving surface of the focus ring, the secondary focus ring including an inner radial edge surface positioned radially outward from the peripheral edge of the substrate,” as recited in amended Claim 1.

Instead, in each of the embodiments of Schneider, the second ring extends underneath the substrate such that the inner radial edge surface of the second ring is not positioned radially outward from the peripheral edge of the substrate. Further, none of the first rings described in Schneider include an outer radial lip surface that is positioned radially outward from a peripheral edge of the substrate.

Accordingly, it is respectfully submitted that Schneider does not disclose or suggest every feature recited in amended Claim 1. Thus, it is respectfully requested that the rejection of Claim 1, and all claims dependent thereon, as anticipated by Schneider be withdrawn.

Regarding the rejection of Claim 6 as unpatentable over Schneider in view of Wicker, it is noted that Claim 6 is dependent on Claim 1 and thus is believed to be patentable for at least the reasons discussed above with respect to Claim 1. Further, it is respectfully

¹ See Schneider, at column 9, lines 20-23 and 64-65 and in Figure 6.

submitted that Wicker does not cure the above-noted deficiencies of Schneider. Thus, it is respectfully requested that the rejection of Claim 6 as unpatentable over Schneider in view of Wicker be withdrawn.

New Claims 28-31 are added by the present amendment. Support for new Claims 28-31 can be found in the original specification, for example, in Figure 4 and in the corresponding description. Thus, it is respectfully submitted that no new matter is added. Further, as new Claims 28-31 are apparatus claims, and not directed to the non-elected method, it is respectfully submitted that these claims should be examined on the merits in their entirety.

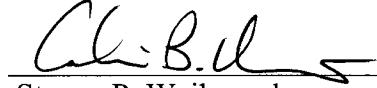
It is noted that new Claims 28 and 29 depend on independent Claim 1, and thus are believed to be patentable for at least the reasons discussed above with respect to Claim 1.

New Claims 30 is an independent claim that recites features similar to those discussed above with respect to Claim 1. Further, new Claim 30 recites that the secondary focus ring is positioned “such that a clearance space exists between the peripheral edge of the substrate and the inner radial edge surface of the secondary focus ring.” Accordingly, it is respectfully submitted that Claim 30, and Claim 31 which depends thereon, patentably define over the cited references.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application and the present application is believed to be in condition for formal allowance. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.



Steven P. Weihrouch
Attorney of Record
Registration No. 32,829

Colin B. Harris
Registration No. 58,969

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)